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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,330	05/20/1998	TORU NAKAMURA	514420-3596	5116

20999 7590 12/20/2002  
FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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DOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

27

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

#### THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

#### PERIOD FOR REPLY [check only a) or b)]

APPROXIMATELY 6

a)  The period for reply expires *12/2/02* months from the mailing date of the final rejection.

b)  In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on *12/2/02*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.  The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.

3.  The proposed amendment(s) will not be entered because:

- (a)  they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b)  they raise the issue of new matter. (see NOTE below);
- (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

*see attached, paragraph 1*

4.  Applicant's reply has overcome the following rejection(s):

5.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

6.  The a)  affidavit, b)  exhibit, or c)  request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached paragraph 3.*

7.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection. *see attached, paragraph 2.*

8.  For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: *16-19, 21-27*

Claim(s) withdrawn from consideration: \_\_\_\_\_

9.  The proposed drawing correction filed on \_\_\_\_\_ a)  has b)  has not been approved by the Examiner.

10.  Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). *26. see attached, paragraph*

11.  Other: *attachment*

*Janie L. Date*  
PRIMARY EXAMINER  
1700

1. The proposed amendments to the specification raise the issue of new matter under 35 U.S.C. 132. There is nothing in the originally filed specification that provides adequate antecedent basis for the descriptions of the intrinsic viscosity measurement and the standard DIN 53461-B disclosed in those amendments.

The proposed amendments to claims 17 and 18, replacing the date of the standard from "Augest 2, 1995" to -- January 1987 -- raise new issues because they were not recited in any previously filed claim. Furthermore, the amendments raise the issue of new matter. There is no disclosure in the originally filed specification that the version of the standard DIN 53461-B is that of January 1987. (Contrary to applicants' statement, the examiner did not suggest that applicants amend the claims to recite the date of January 1987. Rather, the examiner stated "[n]or is there any disclosure in the originally filed specification that would lead a person having ordinary skill in the art [to the conclusion] that the version of the standard [DIN 53461-B] used in the instant specification is that of Jan. 1987." See the final rejection, Paper No. 22, page 18, lines 3-6.

The proposed amendment to claim 22, changing the amount of "less than 50% by weight" to -- not more than 50% by weight -- raises new issues because the amount was not present in previously filed claim 22. Furthermore, the amendment raises the

issue of new matter. The originally filed specification at page 3, lines 10-11, discloses the amount of "less than 50% by weight." The proposed amount of "not more than 50% by weight" includes the amount of 50% by weight, which is outside the scope of the originally disclosed amount.

2. Applicants' exhibits (2) to (4) will not be considered because they are not directed SOLELY to issues which were newly raised by the examiner in the final rejection. The objection to the specification and the rejections of claims under 35 U.S.C. 112, second and first paragraphs, regarding the values of "intrinsic viscosity," and the rejection under 35 U.S.C. 103(a) over JP'864, were presented in the non-final office action mailed Oct. 31, 2001, Paper No. 20, paragraphs 4, 6, 8, and 10, respectively. The objection and rejections under 35 U.S.C. 112, second and first paragraphs, were also presented in the instant application's first office action mailed Jun. 4, 1999, Paper No. 7, paragraphs 2, 5 and 7.

3. (1) The examiner's refusal to enter the proposed amendments and applicants' exhibits filed in the amendment filed after the final rejection in Paper No. 25 on Dec. 2, 2002, renders moot applicants' arguments regarding said amendments and exhibits. Accordingly, the objection to the specification, and rejections

of claims under 35 U.S.C. 112, first and second paragraphs, and the rejection of claims under 35 U.S.C. 103(a) over JP'864 combined with the other cited prior art stand for the reasons of record.

(2) Applicants' arguments with respect to the rejection of claims under 35 U.S.C. 103(a) over JP'864 combined with the other cited prior art are not persuasive for the reasons set forth in the final rejection. Furthermore, there is no disclosure in the instant specification that provides antecedent basis for defining the term  $\alpha$ -olefin, recited in the instant claims, by the formula  $\text{CH}_2=\text{CHR}$ , where R is hydrogen or alkyl, as alleged by applicants. The instant specification does not define the term " $\alpha$ -olefin." As discussed in the rejection, the textbook Grant & Hackh's Chemical Dictionary, fifth edition, page 13, defines methacrylic acid as an alpha olefin acid.

(3) Applicants' arguments regarding the rejection of claims under 35 U.S.C. 103(a) over Masuda combined with Inaba, Minami, as evidenced by the Alrich Catalog, page 1063, and Polymer Technology Dictionary, page 487, are not persuasive for the reasons set forth in the final rejection.

4. The US Patent 5,324,616 listed on the form PTO 1449 filed on Dec. 2, 2002, Paper No. 26, has been deleted because it is

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already listed on the form PTO-892 mailed on Jun. 4, 1999,  
attached to Paper No. 7.